

## REMARKS/ARGUMENTS

### The Restriction Requirement

The Examiner is respectfully requested to reconsider the Restriction Requirement. In order to demonstrate further that the restriction requirement is improper, new dependent claims 27 - 30 have been added which parallel, in many respects, withdrawn claims 15 - 18. Since these new claims depend from claim 1, a restriction requirement is not proper and since claim 1 is patentable over the art, an election of species requirement would not be proper. Since new claims 27 - 30 are properly pending in this application, then the restriction requirement against claims 15-18 can only stand if the Examiner properly asserts that claims 15 - 18 and claims 27 - 30 are patentably distinct. If they are not patentably distinct then the restriction requirement is clearly improper and should be properly withdrawn. As such the Examiner is respectfully requested to reconsider the restriction requirement for all of the presently withdrawn claims. If the Examiner agrees to withdraw the restriction requirement, then there may be some minor amendments which the Examiner would like to see made to the currently withdrawn claims and the Examiner is invited to telephone the undersigned to discuss such amendments.

### The Rejection under 35 USC § 101

Claims 1-14, 19 and 21 were rejected under 35 USC § 101. Claim 1 has been amended to include a recitation of input and output files instead of the display device recommended by the Examiner. It is submitted that generating an output file has at least the same aspect of connoting a practical application as does the suggested display device for representing the data.

Claim 19 has been amended to include the limitation of claim 20, thereby overcoming the rejection of that claim.

Claim 20 has been cancelled without prejudice. But the applicant cannot help but note that the Examiner cites, for the most part, some rather old case to support his contentions. With respect to the Examiner's observation about American Fruit Growers, it can also be presumed that Congress intended to overrule that decision when Congress passed the 1952 act. The Committee Reports accompanying the 1952 Act inform us that Congress intended statutory subject matter to "**include anything under the sun that is made by man.**" S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H. R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952). To the extent that American Fruit Growers is inconsistent with that mandate, it is overruled.

Similarly, the natural phenomena rationale provided by the Examiner is not applicable. Certainly, Einstein could not patent his celebrated law that  $E=mc^2$  and nor could Newton have patented the law of gravity. Such discoveries are manifestations of nature, free to all men and reserved exclusively to none. But the Supreme Court reminds us in *Diamond v. Chakrabarty*, 447 U.S. 303 (1980) that a new life form is not a "natural phenomenon" and it is submitted that a claim to a new energy form is likewise not directed to a "natural phenomenon".

The Examiner asserts that a method must have steps. Interesting proposition, but the statutory language is "process" and not "method", so the assertion is, with all due respect, irrelevant. The prior art is replete with references to such things as "electromagnetic processes". If an electromagnetic process is not naturally occurring, but rather is man made, then it is submitted that it clearly falls within the scope of that which Congress has instructed is patentable subject matter, provided, of course, it is not obvious in view of the prior art. How the USPTO can possibly assert that such processes are not subject to patent protection simply because they allegedly do not have steps

flies in the face of the will of Congress. It is not up to the USPTO to rewrite the Patent Act for Congress and therefore it is utterly improper for the USPTO to graft a requirement for steps that which comprise a process. Recall that statutory subject matter is to **"include anything under the sun that is made by man"** and the USPTO should not be taking a contrary position.

Claim 21 as amended recites:

A computer program according to claim 19 wherein the computer readable medium is an electric carrier signal and wherein the instructions are carried on said electrical carrier signal.

The term "medium" can be defined as "an agency by which something is accomplished, conveyed, or transferred." That could be a compact disk, a electromagnetic signal or any other agency "by which something is accomplished, conveyed, or transferred." Electromagnetic signals, including those in the form of an electrical carrier signal, have just as much reality as a CD or any other agency by which something is accomplished, conveyed, or transferred. And when the instructions are carried on the electrical carrier signal it certainly is a medium which is naturally occurring any more than is a CD loaded with instruction naturally occurring. The natural phenomenon rationale for rejecting claim 21 just does not apply. This claim is not  $E=mc^2$ !

#### The prior art rejections

Claim 1 is rejected as being fully anticipated by Britton. However, the rejection of claim 1 only makes sense if it is assumed, as the Examiner does in the official action, that if the first set of rules does nothing so that the "data is translated until all relevant data has been translated into the new language" as asserted by the Examiner at the top of page 8 of the official action. In reality, the

Examiner is trying to read the limitation of "a first set of rules, which operate, *inter alia* to define a stage at which such a processing operation ceases" on doing nothing whatsoever. That is not believed to be proper. The words of a claim mean something and to effectively ignore what they say is a convenient, but improper, way to reject a claim.

Moreover, the Examiner's rejection of claim 1 is utterly inconsistent with the rejection of claim 2. Claim 2 recites that "the first and third sets of rules are the same." The Examiner, in the rejection of claim 2, explains what the prior art rules do. See the long explanation bridging pages 8 and 9 of the official action. Well, if the third rules are the same as the first rules, and the rules do a lot of things (as described by the Examiner), that is utterly inconsistent with the rejection of claim 1 wherein the Examiner just asserted that the first rules do effectively nothing. Which is it? With all due respect, it can't be both!

Claim 1 has also been amended to reflect the fact that the rules operate in a computer or data processing system as opposed to being some sort of rule applied by manually editing data by a computer user. See the Examiner's comments regarding the second set of rules in Britton on page 8 of the official action.

Claim 1 is believed to clearly differentiate itself from Britton.

Claim 19 as examined makes it more than clear that the program "when loaded onto a computer, cause the computer to process data by: ... applying to the partly-processed data a second set of rules, which operate to modify the data, so that the modified data may be processed in accordance with a third set of rules." That language clearly excludes manually editing data by a computer user sitting at a computer. The rejection of claim 19 is clearly improper and should be withdrawn

New claims 27-30 have already been discussed above.

New claims 31 and 32 make it even more clear that the first set of rules cannot do nothing (as assumed by the Examiner in the analysis of the prior art).

Reconsideration is requested

Withdrawal of the rejections and allowance of the claims are respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

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[Signature]  
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March 23, 2007  
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Respectfully submitted,

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